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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,264	03/06/2002	Ambrose Cheung	DC-0187	9270

7590 07/08/2004

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EXAMINER	
PATTERSON, CHARLES L JR	
ART UNIT	**PAPER NUMBER**
1652	

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,264	CHEUNG, AMBROSE	
	Examiner	Art Unit	
	Charles L. Patterson, Jr.	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, 8-10, 23 and 25, drawn to a nucleic acid, a composition comprising the nucleic acid and a transposon, a vector, a host cell and a kit to identify the nucleic acid, classified in class 435, subclass 6, 320.1, 252.3 and class 536, subclass 23.2.

II. Claims 5-7 and 11-12, drawn to a polypeptide, classified in class 435, subclass 195.

III. Claims 13-21, drawn to a method for identifying agents which inhibit growth and infectivity comprising identifying agents that inhibit expression of the nucleic acid sequence of Group I, a method of inhibiting growth and infectivity comprising contacting the bacteria with the agent and a pharmaceutical composition for use as an antibacterial agent comprising an agent which inhibits the expression of the nucleic acid of Group I, classified in class 435, subclass 6 and numerous subclasses in class 424 and 514, depending upon what the inhibitor is.

IV. Claims 13-21, drawn to a method for identifying agents which inhibit growth and infectivity comprising identifying agents that inhibit the activity of the polypeptide of Group II, a method of inhibiting growth and infectivity comprising contacting the bacteria with the agent and a pharmaceutical composition for use as an antibacterial agent comprising an agent which inhibits the activity of the polypeptide of Group II, classified in class 435, subclass 6 and numerous subclasses in class 424 and 514, depending upon what the inhibitor is.

V. Claims 22 and 24, drawn to a kit to identify the polypeptide of Group II, whereby the polypeptide is indicative of the susceptibility to treatment for a bacterial infection, the classification of which is impossible because the claims do not identify the components of the kit.

The inventions are distinct, each from the other because:

Groups I and II are drawn to two completely different chemical compounds that are patentably distinct. It is noted that although the examiner could have separated the two groups into four due to the different nucleic acid sequences of SEQ ID NO:1 and 3 and the proteins encoded by them, he chose not to because apparently SEQ ID NO:3 is a shortened version of SEQ ID NO:1.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as to produce a polypeptide or to identify the presence of the nucleic acid not involved with identifying agents that inhibit the expression of the nucleic acid.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a

materially different process such as for its activity not involved with identifying agents that inhibit the activity of the polypeptide.

Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be use in a materially different process such as for its activity or to identify agents that inhibit the activity. It is noted that it is impossible to classify Group V because the components are not given in the claims, as stated *supra*. However, unlike claims 23 and 25 which were placed in Group I, the claims of Invention V contain an additional limitation that "detection of the RAT mutant polypeptide is indicative of the susceptibility to treatment for bacterial infection". This adds an addition requirement to the instant claims that is not present in Group II and therefore these claims would be properly separated from Group II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose

telephone number is 571-272-0936. The examiner can normally be reached on Monday - Friday from 7:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
July 1, 2004